

REMARKS

By this amendment, Applicants have amended claims 1, 2, 6-7, 12-24, 28-36, 40-41, 45-46, 51-71, 79-81 and 85-88. Claims 38 and 77 have been canceled without disclaimer and Applicants reserve the right to pursue these claims in one or more continuation/divisional applications.

Support for the amendments to claims 1, 40, 81 and 88 can be found in the specification at, for example, page 2, lines 30-33, page 6, lines 12-28, page 14, lines 1-30, page 18, line 25 to page 19, line 23, claims 56, 65-67 and Figures 6 and 7 and previously presented claims 85 and 86. Claims 2, 6-7, 12-24, 28-36, 41, 45-46, 51-71, 79-80 and 85-87 have been amended according to the Examiner's recommendations.

No new matter has been added by this amendment. Applicants respectfully request entry of the amendment and allowance of the pending claims.

Rejection under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 38 and 77 as allegedly indefinite for the phrase "the witness is a process" recited in the claims. Applicants respectfully disagree with the Examiner and submit that the claims are clear to a person of ordinary skill in the art upon reading the specification. However, solely to expedite prosecution, Applicants have canceled claims 38 and 77 without disclaimer. Accordingly, Applicants submit that this rejection is now moot.

Rejection Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1, 2, 4-6, 12, 14-25, 28-38, 40-41, 43-45, 51, 53-82 and 85-87 under U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,418,457 (Schmidt). Applicants respectfully traverse this rejection.

For a rejection to be sustained under 35 U.S.C. §102(b), each and every element of the claims must be disclosed in the cited prior art reference. Claims 1, 2, 4-6, 12, 14-25, 28-37, 40-41, 43-45, 51, 53-76, 77-82 and 85-87 have been amended to include that pieces of intellectual property related to a first idea, invention, patent, trademark, trade

secret, copyright are linked together to a second idea related to a second idea, invention, patent, trademark, trade secret, copyright and combined to create new intellectual property. Thus the systems and methods allow, for example, a first idea, invention, patent, trademark, trade secret, or copyright to be linked with another piece of intellectual property relating to a second idea, invention, patent, trademark, trade secret, or copyright and combined to form new intellectual property. See, for example, the specification at page 6, lines 12-28, page 14, lines 1-30, and Figures 6 and 7. Schmidt simply does not disclose at least this aspect of the present claims.

For example, the systems and methods allow a first user to take an existing trademark in the database, let's say the company's logo trademark and a second user to take a patented item, for example, a method of lighting an office and link them together and then combine them into new intellectual property, for example, a patent for a method of lighting an office, which lights the company's trademark so that when customers walk in they will see the company's trademark illuminated on the wall. Schmidt simply does not disclose a system or method that allows the linking and combination of intellectual property to create new intellectual property.

Schmidt discloses a document storage system for inventors that utilize time stamps and digital signatures. Schmidt uses software such as Lotus Notes® to add entries and focuses on having those entries electronically signed and witnessed. (See Figures 5a-5j).

Schmidt does not disclose methods and systems that take pieces of intellectual property (e.g., ideas, inventions, patents, trademarks, trade secrets, copyrights, *etc.*) from two different users that could even be from different organizations and link them together, store them, track them, and combine them to create new intellectual property ideas, inventions, patents, trademarks, trade secrets, or copyrights.

The Examiner points to Schmidt at column 1, line 1 to column 10, line 19 for illustrating a patent database, which saves all documents associated with the project and allows the patent attorney to write a patent application. However, the database that Schmidt's system discloses saves one project, one idea that gets sent to the patent attorney to file a patent application. The system and method does not combine an

existing idea, invention, patent, trademark, trade secret, or copyright from two different users and link them together, store them, track them, and combine them to create new intellectual property ideas, inventions, patents, trademarks, trade secrets, copyrights. These new ideas can be further combined to create new ideas and each combination can combine any number of component ideas. In fact, Schmidt does not mention trademarks, trade secrets, or copyrights at all. Schmidt's system could not handle trade secret information as this would be lumped with the patent application and filed by the attorney causing the trade secret to be lost when the patent application publishes.

Moreover, Schmidt is concerned with getting the notebook witnessed and then sending the disclosure to the legal department for patent application drafting. Thus there is one project (one idea) sent to the patent attorney for filing. There is no linking ideas, inventions, patents, trademarks, trade secrets, or copyrights with other ideas, inventions, patents, trademarks, trade secrets, or copyrights and combining them to form new intellectual property. Thus, Schmidt's starting material stored in the database is different than that claimed. Further, Schmidt does not disclose ways to manage the intellectual property.

With regard to claims 2 and 82, the system and methods utilize a crediting process to credit each user with their contribution to the new intellectual property. Schmidt simply does not disclose this feature. Schmidt merely discloses listing inventors. Schmidt does not disclose, teach or suggest a crediting process to credit each user with their contribution to the new intellectual property (*e.g.*, % contribution to the new idea, invention, patent, trademark, trade secret, or copyright).

With regard to claims 39 and 78, the system and methods utilize a digital fingerprint for each piece of content. Schmidt simply does not disclose this feature. Schmidt merely discloses saving documents and allowing a witness and a digital signature to be added after the document is saved.

Accordingly, it is an object of the present invention to create a document storage system that allows documents to be created and protected against any further modification **except for the addition of a Witness statement, time stamps and digital signatures.**

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(Schmidt at Summary of Invention col. 2, lines 44-48, emphasis added). Accordingly, Schmidt does not disclose associating a digital fingerprint with each piece of content.

With regard to claim 87, the system further comprises a custodian workstation allowing a custodian to verify the integrity of the information and an administrator workstation to allow an administrator to oversee the users. Schmidt does not disclose these workstations and the functions associated with them.

In summary, Schmidt does not disclose each and every element of the claims and Applicants request that this rejection under 35 U.S.C. §102(e) be reconsidered and withdrawn.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 3, 7-11, 13, 39, 42, 46-50, 83, 84, 78, 88 as allegedly unpatentable over Schmidt in view of U.S. Patent No. 6,868,402 (Hirota) or Schmidt in view of U.S. Patent No. 6,665,656 (Carter) or Schmidt in view of Techex or Schmidt in view of U.S. Patent No. 6,314,425 (Serbinis). Applicants respectfully disagree with the Examiner, and traverse these rejections.

The teachings of more than one reference may be considered in combination provided one of ordinary skill in the art would combine the references in that way to solve the problem facing the inventor. *KSR International Co. v. Teleflex Inc.* 127 S. Ct. 1727, 1734 (April 30, 2007). Applicants respectfully submit that the cited prior art does not render the present claims obvious and one of ordinary skill in the art would not combine the references in the manner that the Examiner applies them.

Applicants refer the Examiner to the arguments made above regarding the Schmidt reference and submit that Schmidt's system saves one project, one idea that gets sent to the patent attorney to file a patent application. Schmidt's system and method does not combine an idea, invention, patent, trademark, trade secret, or copyright from two different users and link them together, store them, track them, and combine them to create new intellectual property ideas, inventions, patents, trademarks, trade secrets, or copyrights. In fact, Schmidt teaches one idea or one project and does not mention trademarks, trade secrets, copyrights at all.

Moreover, Schmidt does not disclose ways to value the intellectual property including tracking an estimated, market, compound, or a proportional value associated with the intellectual property.

Schmidt equates value of the inventor's entry with the technology value and not estimating a value for the intellectual property in any way:

As a further guarantee of the integrity of the data within the notebook database, certain documents of **exceptional value** would be certified via an electronic Public Notary to provide independent certification of the date and non-modification of the document in the database.

Schmidt (col. 2, lines 24-28, emphasis added). There is simply no concept of economic value for the intellectual property disclosed in Schmidt or management of intellectual property over its life cycle beyond filing the patent application.

Hirota does not solve the unsolved problems of Schmidt. First, Hirota is directed to a method of making payments over a financial server- not creating and managing intellectual property.

The present invention is directed to a document transmitting method and also a document transmit system by which various sorts of documents are transmitted/accepted in the form of electronic data, and fee/charge are paid, and further fee/charge payments are accepted in the form of electronic data in connection with transmission/acceptance of these documents.

(Hirota Col. 1, lines 6-12) Second, Hirota does not combine an idea, invention, patent, trademark, trade secret, or copyright from two different users and link them together, store them, track them, and combine them to create new intellectual property ideas, inventions, patents, trademarks, trade secrets, or copyrights. In fact, Hirota does not mention ideas, inventions, patents, trademarks, trade secrets, or copyrights at all. It is unclear why Hirota is being cited and combined with Schmidt as one of ordinary skill in the art would not go to Hirota to solve the problems unsolved by Schmidt.

Carter does not solve the problems unsolved by Schmidt and Hirota. Carter discloses an improved method for evaluating an intellectual property portfolio.

Generally, this automated, intelligent asset method enables assets, such as patents, **to be evaluated** in an improved manner that may be less time consuming, less prone to human error, more timely in its execution, less costly overall, and/or less resource limited than conventional human-intensive and management methods.

(Carter col. 2, lines 29-34, emphasis added) Carter does not combine an idea, invention, patent, trademark, trade secret, or copyright from two different users and link them together, store them, track them, and combine them to create new intellectual property ideas, inventions, patents, trademarks, trade secrets, or copyrights. It is unclear why Carter is being cited and combined with Schmidt as one of ordinary skill in the art would not go to Carter to solve the problems unsolved by Schmidt.

Techex does not solve the problems unsolved by Schmidt, Hirota and Carter. Techex is a system that allows licensing between technology transfer offices. Techex does not disclose, teach or suggest methods and systems that take pieces of intellectual property (e.g., ideas, inventions, patents, trademarks, trade secret, or copyrights) from two different users and link them together and combine them to create new intellectual property as presently claimed. It is unclear why Techex is being cited and combined with Schmidt as one of ordinary skill in the art would not go to Techex to solve the problems unsolved by Schmidt.

Serbinis does not solve the problems unsolved by Schmidt, Hirota, Carter, and Techex. Serbinis provides a system that allows access to the database by providing certain security tokens. Serbinis does not disclose, teach or suggest methods and systems that take pieces of intellectual property (e.g., ideas, inventions, patents, trademarks, trade secret, or copyrights) from two different users and link them together and combine them to create new intellectual property as presently claimed. It is unclear why Serbinis is being cited and combined with Schmidt as one of ordinary skill in the art would not go to Serbinis to solve the problems unsolved by Schmidt.

With regard to claims 2 and 82, the system and methods utilize a crediting process to credit each user with their contribution to the new intellectual property. None of the cited references make obvious this feature. With regard to claims 39, and 78, the system

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and methods utilize a digital fingerprint for each piece of content. None of the cited references make obvious this feature. With regard to claim 87, the system further comprises a custodian workstation allowing a custodian to verify the integrity of the information and an administrator workstation to allow an administrator to oversee the users. None of the cited references make obvious these workstations and the functions associated with them.

In summary, none of the cited references (Schmidt, Hirota, Carter, Techex or Serbinis) alone or in combination render obvious the pending claims. Accordingly, Applicants request that the rejections under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

Reconsideration and allowance are respectfully solicited.

Applicant's hereby requests a three-month extension of time under 37 CFR 1.136(a) and authorizes the Patent Office to charge the Deposit Account No. 11-0171 in the amount of \$525. No additional fee is believed to be due with respect to filing this amendment. If any additional fees are due, or an overpayment has been made, please charge, or credit, our Deposit Account No. 11-0171 for such sum.

If the Examiner has any questions regarding the present application, the Examiner is cordially invited to contact Applicant's attorney at the telephone number provided below.

Respectfully submitted,



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